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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,114	10/30/2003	Dana Ault-Riche	17102-010001 / 25885-1759	7825
20985	7590	06/30/2006	EXAMINER	
FISH & RICHARDSON, PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			SHIBUYA, MARK LANCE	
			ART UNIT	PAPER NUMBER
			1639	

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/699,114

Applicant(s)

AULT-RICHE ET AL.

Examiner

Mark L. Shibuya

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/21/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-79 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-79 are pending.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 2-26, 33-49, 70, drawn to a method for capturing biological particles, classifiable in class 435, subclass 7.1.
 - II. Claims 27-32, drawn to the method of claim 1, wherein each locus in the capture system further comprises a secondary agent, classifiable in class 435, subclass 7.1.
 - III. Claims 50, 51, drawn to drawn to a method to identify test compounds that alter binding of biological particles to the capture system or an activity or property of the biological particles, comprising performing the method of claim 1, wherein the contacting is performed in the presence and absence of a test compound and the results are compared, classifiable in class 435, subclass 7.1.

- IV. Claim 52, drawn to a method of identifying molecules that interact with infectious agents, comprising performing the method of claim 1, classifiable in class 435, subclass 7.1.
- V. Claims 53-54, drawn to a method for profiling the surface of a biological particle, comprising performing the method of claim 1, classifiable in class 435, subclass 7.1.
- VI. Claims 55-59, drawn to a method for identifying a modulator of an interaction among proteins in a biological particle, comprising performing the method of claim 1, classifiable in class 435, subclass 7.1.
- VII. Claims 60, 61, drawn to a method of identifying a molecule that modulates the trafficking in biological particles, comprising performing the method of claim 1, classifiable in class 435, subclass 7.1.
- VIII. Claims 62-65, drawn to a method of identifying a test compound that modulates trafficking in the biological particle, comprising performing the method of claim 1, classifiable in class 435, subclass 7.1.

- IX. Claims 66-69, drawn to a method of mapping epitopes of molecules displayed on the surface of a biological particle, comprising performing the method of claim 1, classifiable in class 435, subclass 7.1.
- X. Claims 71-73, drawn to a method of sorting biological particles, classifiable in class 435, subclass 7.1.
- XI. Claims 74, 75, drawn to a method of identifying a receptor on the surface of biological particles that transduces a signal from a polypeptide, comprising performing the method of claim 1, classifiable in class 435, subclass 7.1.
- XII. Claims 76, 77, drawn to a method for identifying a molecule that interacts with an apically-localized molecule on a biological particle, classifiable in class 435, subclass 7.1.
- XIII. Claims 78, 79, drawn to a method for identifying molecules that modulate an activity or a functional or structural property in or of the biological particles, comprising performing the method of claim 1, classifiable in class 435, subclass 7.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I-XIII and are directed to related processes. The related inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.05(j). In the instant case, each of the Inventions of different Groups are drawn to methods with materially different functions and effects. Also, in regard to the Invention of Group II, the secondary agent may be a member of a library.

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Claim 1 link(s) inventions I and II-XIII. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claim 1. Upon the indication of allowability of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise requiring all the limitations of the allowable linking claim(s) will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104. Claims that require all the

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limitations of an allowable linking claim will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier.

Amendments submitted after final rejection are governed by 37 CFR 1.116;

amendments submitted after allowance are governed by 37 CFR 1.312.

Applicant(s) are advised that if any claim(s) including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. In re Ziegler, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Election of Species

3. This application contains claims directed to the following patentably distinct species: Applicant must elect a species of ultimate biological particle, and indicate how the claims read upon the elected species. The species are independent or distinct because the different particles have different molecular structures which result in materially different modes of operation, function and effect.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-79 are generic.

4. This application contains claims directed to the following patentably distinct species: Applicant must elect an ultimate species of tagged molecule and indicate how the claims read upon the elected species. The species are independent or distinct because the different tagged molecules have different molecular structures which result in materially different modes of operation, function and effect.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-79 are generic.

5. This application contains claims directed to the following patentably distinct species: Applicant must elect an ultimate species of capture agent, and indicate how the claims read upon the elected species. The species are independent or distinct because the different capture agents have different molecular structures which result in materially different modes of operation, function and effect.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-79 are generic.

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6. This application contains claims directed to the following patentably distinct species: A species of diversity. Applicant should indicate how the elected species reads upon the claims. The species are independent or distinct because they have materially different effect.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 6 are generic.

7. This application contains claims directed to the following patentably distinct species: Applicant must elect between capture systems that comprise arrays or particulate supports. The species are independent or distinct because the different capture systems have materially different design and mode of operation.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

8. This application contains claims directed to the following patentably distinct species: Applicant must elect a solid support that is silicon, celluloses, metal, polymeric surfaces, radiation grafter support, gold, nitrocellulose, etc., and indicate how the claims of the elected Invention read upon the elected species. The species are independent or distinct because the different solid support have materially different design, function and effect.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 18, 19, 20, 21, 23, 24, 25, 26, are generic.

9. This application contains claims directed to the following patentably distinct species: Capture agents that are addressed by linking or association with electronic chemical, optically or color-coded labels. The species are independent or distinct because the different capture agents have materially different design, mode of operation, and function.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-79 generic.

10. This application contains claims directed to the following patentably distinct species: Applicant must elect an ultimate species of second agent and indicate how the claims of Group II read upon the elected species. The species are independent or distinct because the different species of second agent have different molecular structures that result in materially different modes of operation, function and effect.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 27-32 are generic.

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11. This application contains claims directed to the following patentably distinct species: An ultimate species of stain. Applicant must indicate how the claims read upon the elected species. The species are independent or distinct because they have different molecular structures that result in materially different modes of operation.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-79 are generic.

12. This application contains claims directed to the following patentably distinct species: An ultimate species of infectious agent. The species are independent or distinct because the different infection agents have materially different function and effect.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 52 and 53 are generic.

13. This application contains claims directed to the following patentably distinct species: A species of interaction among proteins. Applicant must indicate how the elected species read upon claims 55-59. The species are independent or distinct because the different species of interaction have materially different modes of operation.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 55-59 generic.

14. This application contains claims directed to the following patentably distinct species: A species of physical or chemical change. The species are independent or distinct because they have materially different modes of operation, function and effect.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 55, 56 are generic.

15. This application contains claims directed to the following patentably distinct species: A species of biopolymer. The species are independent or distinct because the different species have materially different design by virtue of materially different molecular structure. The species elected should be consonant with the species of interaction elected, as required in above paragraph 12.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 55, 59 are generic.

16. This application contains claims directed to the following patentably distinct species: Applicant must elect a species of test compound. The species are

independent or distinct because the different test compounds have different molecular structures that result in materially different design, mode of operation, function and effect.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 50, 51, 54, 55, 58, 61, 62,63, 64, are generic.

17. This application contains claims directed to the following patentably distinct species: A species of activity, function or structural property of a biological particle, that is proliferation, apoptosis, etc. Applicant must indicate how the elected species read upon the claims. The species are independent or distinct because the different functions, etc., have materially modes of operation and function.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 64, 65, 78, 79 are generic.

18. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

19. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

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20. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Shibuya whose telephone number is (571) 272-0806. The examiner can normally be reached on M-F, 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Paras can be reached on (571) 272-4517. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Mark L. Shibuya
Examiner
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